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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/752,870

01/07/2004

Yoshifumi Kojima

121036-0066

4882

35684

7590

03/21/2006

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EXAMINER

HU, HENRY S

ART UNIT

PAPER NUMBER

1713

DATE MAILED: 03/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

CM

Office Action Summary	Application No. 10/752,870	Applicant(s) KOJIMA ET AL.	
	Examiner Henry S. Hu	Art Unit 1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on IDS of January 7, 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-25 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. It is noted that USPTO has received an IDS filed on January 7, 2004. **Claims 1-25** with a total of two independent claims (Claim 1 and Claim 3) are pending now. An action follows.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. **Claims 1-2, 5, 8, 11, 14, 17, 20 and 23, drawn to a fluoroelastomer blend composition comprising a terpolymer of VDF/PMVE/TFE and a liquid fluoroelastomer, classified in class 526, subclass 247.**

- II. **Claims 3-4, 6-7, 9-10, 12-13, 15-16, 18-19, 21-22 and 24-25, drawn to a different fluoroelastomer blend composition comprising a dipolymer of VDF/HFP and a liquid fluoroelastomer, classified in class 526, subclass 255.**

3. The inventions are distinct, each from the others because of the following reasons:

Groups I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case invention

Art Unit: 1713

Group I was drawn to a fluoroelastomer blend composition comprising a **terpolymer of VDF/PMVE/TFE and a liquid fluoroelastomer**, while Group II was drawn to a different fluoroelastomer blend composition comprising a **dipolymer of VDF/HFP and a liquid fluoroelastomer**, therefore the scope of the claims, i.e., the metes and boundaries are distinct.

4. Although both inventions may contain the same type of **liquid fluoroelastomer**, they are actually two different blend compositions due to the presence or absence of other monomeric units inside fluorinated copolymer (including terpolymer). In addition to VDF monomer, it is noted that Group I requires PMVE and TFE monomers, while Group II requires HFP monomer.

5. With such a sophisticated monomeric composition in copolymer, **the resulted blend composition obtained from Group II will behave at least somewhat different from that of Group I**. The property and performance are unique and thereby not interchangeable. Two independent claims (Claim 1 and Claim 3 marked with underline) are now pending, and each independent claim carries its set of dependent claims.

6. Because these inventions are distinct for the reasons given above and the search required for each group is not required for other groups have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Art Unit: 1713

7. It is noted that no phone call was made to **Michael S. Gzybowski (registration # 32,816, tel: 734 995-3110)** by the examiner due to the complexity on this particular case. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

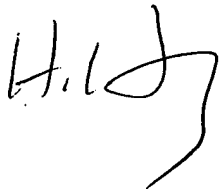
Conclusion

9. Any inquiry concerning this communication or earlier communication from the examiner should be directed to **Dr. Henry S. Hu** whose telephone number is **(571) 272-1103**. The examiner can be reached on Monday through Friday from 9:00 AM –5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached on (571) 272-1114. The fax number for the organization where this application or proceeding is assigned is **(571) 273-8300** for all regular communications.

Art Unit: 1713

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Henry S. Hu

Patent Examiner, Art Unit 1713, USPTO

March 21, 2006



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SUPERVISORY PATENT EXAMINER
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